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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,660	01/14/2004	Markus Allemann	0212.66402	4465
24978	7590	03/08/2006	EXAMINER	
GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606			GATES, ERIC ANDREW	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/757,660	Applicant(s) ALLEMANN ET AL.	
	Examiner Eric A. Gates	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 9 December 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 1 recites the limitation "the type" in line 2. There is insufficient antecedent basis for this limitation in the claim.
5. Regarding claim 1, the phrase "of the type" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(b). Claim 1 would be clearer if the phrase "of the type" was removed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3-5, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Sjostrom (U.S. Patent 5,712,543).
8. Regarding claim 1, Sjostrom discloses a control mechanism 205 for a rotary hand tool 100 of the type having a generally cylindrical housing 105 in which a drive motor 120 is located, the housing having a nose portion (not labeled, left side in figure 1) at an end from which a motor output shaft 115 extends (see figure 2, shaft extends (primary definition "to stretch out", per Oxford online dictionary) from motor in nose portion) and a grip portion 655 around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said mechanism comprising: an electrical control circuit 215 that controls the application of power to and the operation of the motor, including supplying current to the motor (through cable 145); and a light touch switch 135 having at least a first position (not pushed) and a second position (pushed) (see column 1, lines 25-27) coupled to said electrical control circuit for selectively enabling or disabling said control circuit to turn the motor on and off (see column 4, lines 64-65), wherein said motor current does not flow through said switch (see column 4, lines 41-45); wherein said switch is disposed on a portion of the nose portion of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.
9. Regarding claim 3, Sjostrom discloses wherein said switch has a predetermined thickness (identically sized per column 4, line 50).

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10. Regarding claim 4, Sjostrom discloses wherein said first position disables said electrical control circuit and said second position enables said electrical control circuit (see column 4, lines 64-65).

11. Regarding claim 5, Sjostrom discloses wherein said portion of the nose portion on which said switch is disposed generally corresponds to a location of the operator's index finger when grasping the tool (see figure 1).

12. Regarding claim 10, Sjostrom discloses an apparatus 200 for selectively controlling power applied to and the operation of the motor 120 of a rotary hand tool 100 of the type having a generally cylindrical housing 105 that includes a generally cylindrical nose portion (not labeled, left side in figure 1) at an end from which an output shaft extends (see figure 2, shaft extends (primary definition "to stretch out", per Oxford online dictionary), and a grip portion 655 around which an operator wraps a hand during operation of the tool, said apparatus comprising: a switch 135 having a switch button 135 and containing at least a pair of switch contacts (see column 1, lines 25-27) that are selectively opened and closed responsive to actuation of said switch button, said switch being operatively connected to said control circuitry to control the operation of the motor, including the application of motor current to the motor (see column 4, lines 64-65), said switch being configured so that said motor current does not pass through the switch contacts during operation of the motor (see column 4, lines 41-45); and a cavity 175 disposed in the nose portion of the tool that is configured to receive at least a portion of said switch and permit actuation of said switch button.

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13. Regarding claim 12, Sjostrom discloses that the outer surface of said switch button 135 is generally coextensive with the outer surface of said nose portion.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sjostrom in view of Markle et al. (U.S. Patent 4,772,765).

16. Regarding claim 2, Sjostrom discloses the invention substantially as claimed, except Sjostrom does not disclose wherein said switch is configured to be generally rectangular.

17. Markle et al. teaches the use of a rectangular switch 28 for the purpose of convenience of use. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Sjostrom with the rectangular switch of Markle et al. in order to have a tool with a switch conforming to whatever shape was desired or convenient.

18. Claims 6-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjostrom in view of Von Hollen (U.S. Patent 3,640,635).

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19. Regarding claim 6, Sjostrom discloses the invention substantially as claimed, except Sjostrom does not disclose a layer of flexible grip material surrounding at least a portion of the nose portion.

20. Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the grip portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Sjostrom with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

21. Regarding claims 7-11, the modified invention of Sjostrom discloses the invention substantially as claimed.

Response to Arguments

22. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

23. For the reasons as set forth above, the rejections are maintained.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

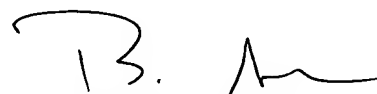
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EAG
23 February 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER